

REMARKS***Amendment to the Specification and Claims***

The specification has been amended to update the status of the parent application.

For ease of examination/prosecution purposes, new claims 27-34 have been added. Claim 27 includes a combination of elements from original claims 1 and 2. Claims 28 and 29 are analogous to original claims 3 and 4 (note that for claims 27-29, hydrogen has been deleted as being part of variable Y).

Claims 30-33 represent a narrower embodiment of the invention. Support for this limitation can be found by the examples cited in pages 122-123 of the specification.

Claim 34 is essentially original claim 5 limited to the elected invention.

The examiner's suggested format for claim 12 has essentially been adopted. Claims 12, 14 and 27-34 are now pending. It is believed that no new matter has been added.

Response to Restriction Requirement

The applicants confirm that they elected with traverse Example I-2-a-1 on page 122 of the specification and that the examiner has expanded the search of the invention to the formula indicated on page 3 of the Office Action. The applicants traverse the election of species on the grounds that it would not be an undue burden to search the entirety of the invention and that no explanation has been given as to why the entirety of the invention would be unduly burdensome to search (see MPEP 803)

Improper Markush Rejection

It is unclear what is the statutory basis for this rejection but such that it can be understood that this is a request to delete the non-elected subject matter, this has been done. Applicants reserve the right to prosecute non-elected subject matter in a divisional application.

35 U.S.C. 112, second paragraph rejection

Claim 1-5, 12 and 14 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants' regard as his invention. It is believed that the amendments to the claims address the examiner's rejection and as such this rejection can be withdrawn.

35 U.S.C. 102(a) rejection (presumed to mean 102(b)) and 103(a) rejection

Claims 1-5, 12 and 14 were rejected by the examiner as being anticipated by Fischer et al. (U.S. Patent 5,262,383).

It is believed that the claims as amended do not encompass the compounds described by Fischer et al.

The present and original claim limitations require that at least one of X (ortho position) and Y (para position) is not halogen, alkyl, halogenoalkyl or alkoxy. The best possible reading for Fischer et al. in order to support the position that applicants' claims encompass Fischer et al.'s compounds would be that variable Y is hydrogen and that X could be some undisclosed variable. This position would also require

that one of ordinary skill in the art would have been directed to select not only the appropriate number of the variable Z for substitution but also would've know that the location of the variable Z must also be in the ortho position.

MPEP 2131 states that to anticipate a claim, the reference must teach every element of the claim, i.e. "The identical invention must be shown in as complete detail as is contained in the...claim." see *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d, 1913, 1920 (Fed. Cir. 1989), see also *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972) (For a proper anticipation rejection, the reference "must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *Id.* at USPQ 526.).

The claims as amended do not meet these standards of specificity as there are differences between the claimed invention and the invention of the prior art (namely the identity of variable X) and the reference requires picking and choosing in order to arrange the elements properly (e.g. variable Z). For these reasons, it is believed that the claims as amended are not anticipated by Fischer et al.

35 U.S.C. 103(a) rejection

Claims 1-5, 12 and 14 were rejected by the examiner as being obvious over Fischer et al. (U.S. Patent 5,262,383).

The applicants' observations made above in the response to the 102 rejection is to be considered repeated here. As the examiner believed the compounds of Fischer et al. to be encompassed by the applicants' previous claims, no discussion was necessary to address the obviousness of any differences between the invention and the prior art. It is not believed that the claims are obvious in light of the differences that are currently present between the amended claims and Fischer et al. as Fischer et al. provides no guidance as to what other potential variables could be possible for variable X. One of ordinary skill in the art would be reduced to practicing in improper hindsight reconstruction or obvious to try rationales.

Although not believed to be necessary, the applicants also a draft of a Rule 1.132 declaration as evidence of secondary considerations, i.e. substitution with a different moiety besides "alkyl, halogen, alkoxy or halogenoalkyl" results in superior insecticidal effect. The Fischer et al. not only does not teach the use of a halogenoalkyloxy moiety for variable X (or other moieties beyond those specifically disclosed) but does not contemplate that such a substitution would result in the superior insecticidal effects shown in the declaration.

Therefore, for any of the above reasons it is believed that the claims as amended are also unobvious in light of the prior art.

Cl sing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

Norris, McLaughlin & Marcus, P.A.

By: Howard C. Lee
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

Attachment: Example: Tetranychus test (OP-resistant) - 2 pages

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 10 November 2003

By: Agata Glinska
Agata Glinska

Example

Tetranychus test (OP-resistant) (*dip treatment*)

Solvent: 3 parts by weight of dimethylformamide

Emulsifier: 1 part by weight of alkylaryl polyglycol
ether

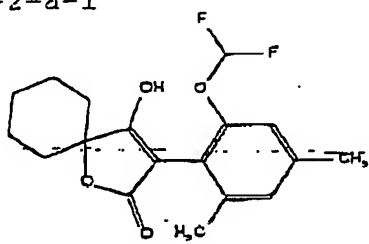
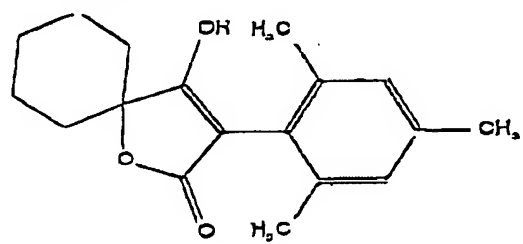
To produce a suitable preparation of active compound, 1 part by weight of active compound is mixed with the stated amount of solvent and the stated amount of emulsifier, and the concentrate is diluted with water to the desired concentration.

Bean plants (*Phaseolus vulgaris*) which are heavily infested with all development stages of the greenhouse red spider mite or two-spotted spider mite (*Tetranychus urticae*) are treated by being dipped into the active compound preparation of the desired concentration.

After the desired time, the destruction is determined in %. 100% means that all spider mites have been destroyed; 0% means that no spider mites have been destroyed.

Table

(plant damaging insects)
Tetranychus test (OP-resistant/dip treatment)

Active compound	Active compound concentration in %	Degree of destruction in % after 13 days
<p>Ex. I-2-a-1</p>  <p>according to the invention</p>	0,0001	100
<p>Ex. I-a-13</p>  <p>known from EP 528 156 (US 5.262.383)</p>	0,0001	0